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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,828	12/12/2003	Roland Deckwer	09879-00039-US BCS 02-100	5323
23416 7590 03/03/2008 CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899			EXAMINER PRYOR, ALTON NATHANIEL	
			ART UNIT 1616	PAPER NUMBER
			MAIL DATE 03/03/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/734,828	<b>Applicant(s)</b> DECKWER ET AL.	
	<b>Examiner</b> ALTON N. PRYOR	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2/12/07;8/10/08.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The last office action (election/restriction requirement) dated 6/14/07 is vacated.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is no longer rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites a various classes of herbicides, some preferred, apparently others not so preferred. The classes are also somewhat "nested" with some classes calling within the scope of others. It is difficult to assess how the claim is structured. It would be preferable to simply recite the various classes in separate dependent claims.

#### ***Response to Applicants' argument***

Claim 2 has been amended to remove the "preferably" language. For this reason, the 35 USC 112, 2<sup>nd</sup> paragraph rejection on record is withdrawn.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 remain rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Schnabel et al (US 6,693,063), Wurtz et al (US 2002/0016263), and Sixl (US 6,479,432). New claims 15 and 16 are added to this rejection.

Schnabel et al teach emulsifiable concentrates (column 10) comprising ALS inhibitors such as sulfonylurea herbicides (columns 19-21) including iodosulfuron (col 19, lines 45-47) and thifensulfuron (col 21, line 36), in combination with safeners (columns 27-28), hydrocarbon solvents (column 15), and wetting agents such as sulfosuccinic acid esters (col 16, lines 20-25).

Wurtz et al teach liquid formulations, i.e., emulsion concentrates (para 12) comprising ALS inhibiting herbicides such as the sulfonamides and sulfonylureas (para 69-120) and polycarboxylic acid derivatives such as sulfosuccinic acid esters (para 44-55). The compositions may further comprise organic solvents and surfactants (para 122-141), and safeners (para 163- 178). Preferred compositions comprise a sodium dialkylsulfosuccinate, one or more sulfonylureas such as iodosulfuron, and a safener such as mefenpyr or isoxadifen (para 181).

Sixl teaches suspension concentrate compositions (abstract) comprising sulfonylurea herbicides (col 3-6), safeners (col 10), organic solvents (col 10-12), emulsifiers (col 12-14), and • other agents (abstract).

One of ordinary skill in the art would be motivated to combine these references in order

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to take advantage of the formulation advantages of the various adjuvant materials in these patents that all pertain to suspensions of sulfonylurea herbicides.

Thus it would have been prima facie obvious to the ordinary artisan at the time the invention was made to have combined applicants' components in a single herbicidal oil suspension concentrate because the prior art teaches that it was well known in the art to combine the disclosed sulfonylurea herbicides, safeners, and solvents in a suspension concentrate, and because Wurtz et al specifically discloses the utility of adding the sulfosuccinate esters in these compositions.

No unobvious or unexpected results are noted; no claim is allowed.

*Response to Applicants' argument*

Applicants' argue that 1) some suggestion or motivation must be stated in the references to modify or combine them 2) a reasonable expectation of success must be expected from the combination of references 3) the prior art must teach all the claim limitations, 4) Schnabel et al and Wurtz et al disclose different types of formulations than the claimed oil suspension concentrates. Schnabel et al mentions that the herbicidal compositions can be formulated in numerous ways, including suspension concentrates, but Schnabel et al only exemplifies a water-soluble concentrate, 5) Schnabel et al discloses composition that can comprise sulfosuccinic acid esters which are auxiliary agents for aqueous dispersions, 6) Wurtz et al discloses liquid formulation comprising sulfosuccinates, 7) Sixl discloses suspension concentrates comprising sulfonylureas in suspended form, 8) none of the references suggest the claimed oil suspension concentrates.

The Examiner argues that all the references cited in the 103(a) rejection are in the herbicide art. Therefore, it would have been expected that their combination would have yielded a composition that would have successfully function as a herbicide. It is obvious to try combining references having the same utility. The combined art yields an invention meeting all instantly claimed limitations comprising sulfonamides, safeners, organic solvents and sulfosuccinates. In the preamble of the instant claims it is recited that the composition is an "oil suspension"; however, the claim does not require a component that makes it oily. It is also important to note that the prior art does not have to exemplify all possible disclosed scenarios to render claims obvious. The prior art suggests the combination of above named ingredients instantly claimed. This renders the instant invention obvious. Also, in a claim to a composition, a statement to the utility of its components has no patentable significance. For these reasons, the rejection on record is maintained.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALTON N. PRYOR whose telephone number is (571)272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alton N. Pryor/  
Primary Examiner, Art Unit 1616

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